

Notice of Allowability

Application No.

09/997,423

Examiner

Diana B. Johannsen

Applicant(s)

GILLIS ET AL.

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the After Final Amendment filed 4/28/04 and the interview concluding 6/8/04.
2. ☒ The allowed claim(s) is/are 1,3-14,16 and 18-20.
3. ☒ The drawings filed on 28 November 2001 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date part of 0604 .
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

EXAMINER'S AMENDMENT

1. This action is in response to the After Final Amendment filed April 28, 2004 and to the interview concluding June 8, 2004. The After Final Amendment has been entered, and the remaining rejections set forth in the prior Office action are moot in view of the entry of the After Final Amendment, and further in view of the below examiner's amendment. Claims 1, 3-14, 16, and 18-20 are now allowed.

2. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Thomas J. Engellenner on June 8, 2004.

3. In accordance with 37 C.F.R. 1.126, allowed claims 1, 3-14, 16, and 18-20 will be renumbered as claims 1-17, respectively (see MPEP 608.01(j)). It is noted that original claim numbers are employed in the below examiner's amendment.

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4. The application has been amended as follows:

a) Cancel claims 2, 15, 17, and 21-34.

b) Amend the claims as follows:

In claim 1, line 3, delete “an FKBP54 marker” and insert therefore—FKBP54--.

In claim 1, line 5, delete “the marker” and insert therefore—FKBP54--.

In claim 1, line 6, delete “of the marker.”

In claim 6, lines 1-2, delete both instances of the recitation “of the marker.”

In claim 7, lines 1-2, delete both instances of the recitation “of the marker.”

In claim 8, lines 1-2, delete “of the marker.”

In claim 8, lines 2-3, delete “a protein corresponding to the marker” and insert therefore—FKBP54 protein--.

In claim 11, lines 1-2, delete “of the marker.”

In claim 11, lines 3-4, delete “wherein the transcribed polynucleotide comprises the marker.”

In claim 14, line 1, delete “step of.”

In claim 14, line 2, after “transcribed polynucleotide” insert—or portion thereof--.

In claim 16, lines 3-4, delete “an FKBP54 marker” and insert therefore—FKBP54-

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In claim 16, line 8, delete “the FKBP54 marker” and insert therefore—FKBP54--.

c) Amend the specification as follows:

On page 7, at line 15, after “GENECHIP®” delete “(Human Expression Analysis Probe Array)”.

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On page 9, at lines 9-10, after "GENECHIP®" delete "(Human Expression Analysis Probe Array)".

On page 12, at lines 10-11, after "GENECHIP®" delete ", Human Expression Analysis Probe Array" and insert therefore—array--.

On page 12, at lines 20-21, after "GENECHIP®" delete "(Human Expression Analysis Probe Array)" and insert therefore—array--.

On page 82, at lines 19-20, after "Enhancement Solution" delete "(to detect the binding of labeled ligands to receptors)".

On page 82, at line 21, after "Victor reader" delete "(PerkinElmer Wallac Inc)".

On page 82, at lines 24-25, after "Midi Kit" delete "(a RNA extraction kit)".

On page 82, at line 26, after "POLYTRACT®" delete "(mRNA Isolation System with cDNA Synthesis Reagents)".

On page 83, at line 22, after "GENECHIP®" delete "(Human Expression Analysis Probe Array)".

On page 84, at line 3, after "GENECHIP®" delete "(Human Expression Analysis Probe Array)".

On page 84, at line 22, after "GENECHIP®" delete "(Human Expression Analysis Probe Array)".

On page 85, at lines 16-17, after "GENECHIP®" delete "(Human Expression Analysis Probe Array)".

On page 85, at lines 17-18, after "RT-PCR kit" delete "(a one-step RT-PCR kit)".

On page 86, at line 2, after "TAQMAN®" delete "(a one-step RT-PCR kit)".

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On page 88, at lines 11-12, after "Assay System" delete "(a luciferase assay system designed for the purpose of providing long-lived luminescence when added to cultured cells)".

On page 89, at line 7, after "GENECHIP®" delete "(Human Expression Analysis Probe Array)".

On page 91, at line 6, after "GENECHIP®" delete "(Human Expression Analysis Probe Array)".

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Substance of Interview concluding June 8, 2004

5. On May 24, 2004, the examiner contacted Applicant's representative to propose amendments to the claims and specification that would place the application in condition for allowance. The examiner noted that the proposed claim amendments clarified that the claims are drawn to methods in which the expression of FKBP54 molecules is assayed (as opposed to, e.g., other molecules that might be considered FKBP54 "markers"). The examiner noted that the proposed amendments to the specification deleted unneeded descriptive information regarding trademarks that appeared to constitute new matter. On June 8, 2004, Applicant's representative authorized the proposed amendments. Accordingly, claims 1, 3-14, 16, and 18-20 are allowed.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diana B. Johannsen whose telephone number is 571/272-0744. The examiner can normally be reached on Monday-Friday, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached at 571/272-0745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Diana B. Johannsen", followed by a long, sweeping horizontal line that extends to the right.

Diana B. Johannsen
Primary Examiner
June 9, 2004